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Docket No.: 220305US0

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COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/091,502
Applicants: Yong CHE, et al.
Filing Date: March 7, 2002
For: SECONDARY POWER SOURCE
Group Art Unit: 1745
Examiner: Alejandro, R.

SIR:

Attached hereto for filing are the following papers:

Second Reply Brief

Our check in the amount of is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
YONG CHE, ET AL.	: EXAMINER: ALEJANDRO, R.
SERIAL NO: 10/091,502	:
FILED: MARCH 7, 2002	: GROUP ART UNIT: 1745
FOR: SECONDARY POWER SOURCE	:

SECOND REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In an Order Returning Undocketed Appeal to Examiner, entered May 18, 2004 (Order), the Board, *inter alia*, quoting 37 C.F.R. § 1.193 and M.P.E.P. 1208.03, noted that after a reply brief to an examiner's answer is filed, the primary examiner must either acknowledge receipt and entry of the reply brief, or withdraw the final rejection and reopen prosecution to respond to the reply brief. The Examiner, however, has done neither. Rather, the Examiner has entered a new Examiner's Answer, dated June 26, 2004 (New Answer). The Examiner also states "that the Reply Brief mailed April 14, 2004 has been vacated." Appellants assume that the Examiner intended the Office communication dated April 14, 2004 which was in response to the Reply Brief of record, as being vacated, since the Examiner has no authority to vacate the Reply Brief, and the Reply Brief was filed on a different date, i.e., March 31, 2004.

The New Answer now excerpts arguments made in the Appeal Brief, and then purports to address them. Nevertheless, there is very little that is new in the New Answer

which has not already been addressed in the Appeal Brief. The only new argument made by the Examiner is that the burden has been shifted to Appellants "to provide objective evidence demonstrating that [Honbo et al's] negative electrode when used as applied in the battery of [Kuruma et al] will indeed cause detrimental effects thereto. That is to say, the burden has shifted to [Appellants] to supply, provide or present objective evidence showing why [Honbo et al's] negative electrode cannot function in a substantially similar battery environment" (New Answer at 16-17 and 24).

In reply, the burden is always with the Examiner to present a *prima facie* case of obviousness. Appellants have already demonstrated in the Appeal Brief why such a case has not been made out. Indeed, the Examiner has not even made out an "obvious to try" case, since Honbo et al discloses nothing relevant to any problems that might be encountered in Kuruma et al. "Obvious to try" has long been held not to constitute obviousness. *In re O'Farrell*, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995).

The Examiner has also sought to explain his reasons for rejecting Claims 11 and 12 only under the judicially created doctrine of obviousness-type double patenting (New Answer at 37-38), in answer to Appellants' point at the penultimate paragraph of page 12 of the Appeal Brief. In reply, these rejections are still untenable, for reasons already advanced in the Appeal Brief.

The Examiner's failure to proceed according to applicable rules, as demonstrated by the Office communication dated April 14, 2004, has already delayed consideration of this appeal. The Examiner's failure now to proceed in accordance with the Order has the potential to further delay such consideration. Therefore, Appellants request that rather than a further remand to the Examiner to proceed in accordance with the Order, the Board accept and

docket this appeal on the present record, thus avoiding both further delay and potential prejudice to Appellants.

Respectfully submitted,

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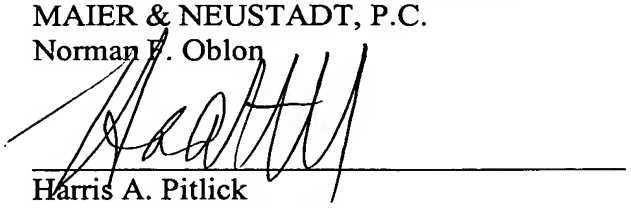

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